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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,873	11/05/2003	Diana Amelia Normington	2003-22	6238
32246	7590	06/14/2005	EXAMINER	
PETER J.C. NORMINGTON 516 COUNTRY PLAZA SOUTH GILBERT, AZ 85234			BLAKE, CAROLYN T	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/701,873

Applicant(s)

NORMINGTON, DIANA AMELIA

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,9,11-13,16,17,20,23,25-27,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9,11-13,16,17,20,23,25-27,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on March 25, 2005.
2. The objection to the specification is withdrawn in view of the amendment.
3. The objection to claim 1 is withdrawn in view of the amendment.
4. The objection to claim 9 is withdrawn in view of the amendment.
5. The objection to claim 16 is withdrawn in view of the amendment.
6. The rejection to claim 1 under 35 USC § 112 is withdrawn in view of the amendment.
7. The rejection to claim 16 under 35 USC § 112 is withdrawn in view of the amendment.
8. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

9. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 30 recites the limitation "the punch pattern" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. Claims 1, 2, 12, 16, 17, 26, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Farmwald et al (2,816,608).

Regarding claims 1 and 16, Farmwald et al disclose a machine for piercing sheets of material comprising: an adjustable apparatus (45) that can be moved by hand; the adjustable apparatus (45) acts as a stop to the moveable cutting die (30) containing the punch pattern thereby varying an amount of a punch pattern cut into a sheet of material being punched; the moveable cutting die (30) is designed with a cutting surface so that said adjustable apparatus (45) can limit the amount of said sheet of said material cut by said cutting surface; the adjustable apparatus (45) can be moved to a position so that said designed pattern of said punch is cut fully out of said sheet of said material by the movement of said moveable cutting die (30); a frame which holds said adjustable apparatus (45) and said moveable punch cutting die (30) with said moveable cutting die (30) held in the top of said frame and a hole (37) corresponding to said moveable cutting die (30) in a base (31) of said frame wherein said frame aligns said moveable cutting die (30) to said hole (37) allowing for said moveable cutting die (30) to be moved through said hole (37); a slot (area between 30 and 31) in said frame with said slot extending partially through said frame to accept and restrain said sheet of said material prior to said sheet of said material being punched; a means to activate (18, 19, 27, 28, etc.) said moveable cutting die (30) moving said cutting die (30) to where it contacts said sheet of said material in said slot cutting said sheet of said material, and a spring (9) installed within said frame to return said moveable cutting die (30) to a starting position allowing easy removal of said sheet of said material.

Regarding claims 2 and 17, Farmwald et al disclose the cutting surface of said moveable cutting die (30) is formed in a curved shape. Note the movable cutting die (30) is a cylinder, so thus the cutting surface is curved.

Regarding claims 12 and 26, Farmwald et al disclose a portion of said adjustable apparatus (45) is fabricated as an integral part of said housing.

Regarding claim 30, Farmwald et al disclose an adjustable apparatus (28) that can be added to existing decorative punches comprising: said adjustable apparatus (45) acts as a stop to a moveable cutting die (30) containing a punch pattern thereby limiting the amount of said punch pattern cut into a sheet of material being punched; said moveable cutting die (30) is designed with a curved cutting surface so that said adjustable apparatus (45) can limit the amount of paper cut by that cutting surface, said adjustable apparatus (45) can be moved to a position so that said designed pattern of said punch is cut fully out of said sheet of material, and said adjustable apparatus (45) can be permanently installed on existing decorative punches.

Regarding claim 31, Farmwald et al disclose an adapter (45) designed to fit on a machine for piercing paper comprising: an adjustable apparatus (45) that can be moved by hand; said adjustable apparatus (45) acts as a stop to the downward motion of said machine thereby controlling the amount of the pattern of said machine that is cut into a sheet of material being pierced; and said adapter (45) can be attached to said machine.

Claim Rejections - 35 USC § 103

12. Claims 1, 2, 11-13, 16, 17, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouldsmith, Jr. (2, 730,811) in view of Farmwald et al.

Regarding claims 1 and 16, Gouldsmith, Jr. discloses a machine for piercing sheets of material comprising: a the moveable cutting die (66) containing a punch pattern thereby varying an amount of the punch pattern cut into a sheet of material being punched; the moveable cutting die (30) is designed with a cutting surface (68); a frame which holds said moveable punch cutting die (66) with said moveable cutting die (66) held in the top of said frame and a hole (20) corresponding to said moveable cutting die (66) in a base (10) of said frame wherein said frame aligns said moveable cutting die (66) to said hole (20) allowing for said moveable cutting die (66) to be moved through said hole (20); a slot (area between 68 and 10) in said frame with said slot extending partially through said frame to accept and restrain said sheet of said material prior to said sheet of said material being punched; a means to activate (84.) said moveable cutting die (66) moving said cutting die (66) to where it contacts said sheet of said material in said slot cutting said sheet of said material, and a spring (80) installed within said frame to return said moveable cutting die (66) to a starting position allowing easy removal of said sheet of said material. Gouldsmith, Jr. fails to disclose an adjustable apparatus. However, Farmwald et al disclose an adjustable apparatus (45) for use in a piercing machine that is capable of adjustment to vary the distance between the punch and the die in order to compensate for wear of the die (col. 3, lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adjustable apparatus, as disclosed by Farmwald et al, on the Gouldsmith, Jr. device for the purpose of varying the distance between the punch and die in order to compensate for wear.

Regarding claims 2 and 17, Gouldsmith, Jr. discloses the cutting surface (68) is formed in a curved shape.

Regarding claims 11 and 25, Gouldsmith, Jr. discloses a housing (38, 48, 52) to enclose said frame and to permanently enclose a portion of said means of activating said moveable cutting die (66).

Regarding claims 12 and 26, Farmwald et al disclose a portion of said adjustable apparatus (45) is fabricated as an integral part of said housing.

Regarding claims 13 and 27, Gouldsmith, Jr. discloses a locking hinge mechanism (34) located at said base (10) of said frame where said locking hinge mechanism (34) allows said base (10) to be moved away from the rest of said machine following said material piercing thereby allowing for easy release of said material and said locking hinge mechanism (34) then allows base (10) to be returned to the original storing position.

13. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmwald et al as applied to claims 1 and 16 above, and further in view of Tanaka (3,472,101). Farmwald et al fail to disclose the means to activate is a lever. However, Tanaka disclose a machine for piercing sheets wherein the means to activate a moveable cutting die (6) is a lever (3) in sliding contact with said moveable cutting die (6), thereby creating the necessary motion when said lever (6) is pushed and wherein said lever (6) is held against the force created by a spring (14) by portions of the frame. The top section of the punch is slidably disposed on the column (7), and thus the lever and the cutting die are in sliding contact. Making the device manually operated would

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make the device less expensive to operate, in particular if production requirements were low. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Farmwald et al device manually operated, as taught by Tanaka, by replacing the structure associated the pressure fluid operation, including the cylinder (6), with the lever of the Tanaka device for the purpose of decreasing operating expenses.

14. Claims 1, 5, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt (2,788,854) in view of Capewell (749,257).

Regarding claims 1 and 16, Brandt discloses a machine for piercing sheets of material comprising: a the moveable cutting die (23) containing a punch pattern thereby varying an amount of the punch pattern cut into a sheet of material being punched; the moveable cutting die (23) is designed with a cutting surface; a frame (including 10, 12, 16, and 18) which holds said moveable punch cutting die (23) with said moveable cutting die (23) held in the top of said frame and a hole (13) corresponding to said moveable cutting die (23) in a base (10) of said frame wherein said frame aligns said moveable cutting die (23) to said hole (13) allowing for said moveable cutting die (23) to be moved through said hole (13); a slot (area between 23 and 10) in said frame with said slot extending partially through said frame to accept and restrain said sheet of said material prior to said sheet of said material being punched; and a means to activate (16) said moveable cutting die (23) moving said cutting die (23) to where it contacts said sheet of said material in said slot cutting said sheet of said material. Brandt fails to disclose a spring or an adjustable apparatus. However, Capewell discloses an

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adjustable apparatus (31) for use in a cutting machine that is capable of adjustment for the purpose of limiting the downward movement of the lever (24). The adjustment apparatus allows the user to create the desired cut with optimized leverage (col. 3). In addition, Capewell discloses a spring (16) installed within the frame to return the movable cutting element (10) to a starting position allowing easy removal of a work piece (col. 2, lines 65-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adjustable apparatus and a spring, as disclosed by Capewell, on the Brandt device for the purpose of creating a desired cut while optimizing leverage and returning the movable cutting element to a starting position for easily removing the work piece.

Regarding claim 5 and 20, Capewell discloses the adjustable apparatus (31) is an externally threaded piece of hardware that is located in a matching threaded insert (col. 3, line 5) of a frame (including 1, 2, 3, 4, 5, 6, and 24) such that said externally threaded piece of hardware (31) can be rotated within said threaded insert moving said threaded piece of hardware (31) up and down thereby adjusting and controlling the amount of travel of said moveable cutting element (10) and acting as said stop.

Response to Arguments

15. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

16. Regarding Applicant's argument the gap in the Farmwald et al and Gouldsmith, Jr. devices is not a slot, a slot is defined as "a narrow opening." The narrow opening from the punch cutting die (30) to the base (31) confined by rod (2) on the Farmwald et

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al device can be considered a slot, as can the narrow opening from the cutting surface (68) to the base (10) confined by the side surfaces (48 and 52). In either case, when the cutting surface/die moves closer to the work piece, the size of the slot decreases and restrains the work piece. Although this differs from Applicant's device wherein the slot is fixed in size, this difference is not claimed.

17. Regarding Applicant's argument the cutting surface of the Farmwald et al device is not curved, the cutting surface of the punch cutting die (30) is circular and thus curved.

18. Regarding Applicant's argument the Farmwald et al device is not a decorative punch, this term is not limited to the type of punch disclosed by Applicant. The Farmwald et al punch could be used to punch holes in a sheet for the purpose of creating a pattern or providing an ornamental element. Accordingly, the Farmwald et al device is a decorative punch. Furthermore, it is noted Applicant admitted on the record the Farmwald et al device could be added to a punch as set forth in claims 30 and 31. See page 18, bottom paragraph of the *Remarks* section.

19. Regarding Applicant's argument the Gouldsmith, Jr. device is not an analogous punch, this does not mean the punch is incapable of creating a hole. Although the device is intended to create a perforation, the device is capable of punching a hole. It would have been obvious to employ the device to make a full punched hole if one so desired, as there is no specific structure to prohibit this from occurring.

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20. Regarding Applicant's argument the Gouldsmith, Jr. device does not disclose a cutting surface, a punching operation can be considering cutting. Accordingly, the punching element (66) has a cutting surface (pointed end 68).

21. Regarding Applicant's argument it is improper to combine the Farmwald et al and Tanaka devices, it is noted Applicant admitted on the record the combination is obvious. See the *Remarks* section, page 23, line 18 to page 24, line 1. In addition, the use of a manual lever instead of pneumatic control would be an economic choice for low production. Also, there are other reasons why the lever may be advantageous, such as decreased complexity of the device and fewer parts.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB

CB
June 6, 2005



Allan N. Shoap
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